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EXAMINER

LEBENTRITT, MICHAEL

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2824

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Paper No. 11

Application Number: 09/761,738
Filing Date: January 18, 2001
Appellant(s): MAEDA, SHIGENOBU

Edwin D. Garlepp

For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 7/22/02.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The rejection of claims 21-24 stand or fall together because appellant's brief does not include a statement that this grouping of claims does not stand or fall together and reasons in support thereof. See 37 CFR 1.192(c)(7).

(8) Claims Appealed

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) Prior Art of Record

Art Unit: 2824

3,760,384

Krolikowski et al

9-1973

(10) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 21-24 are rejected under 35 U.S.C. 102 (b) and 112 2nd paragraph.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-24 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

While applicant may be his or her own lexicographer, a term in a claim may not be given a meaning repugnant to the usual meaning of that term. See *In re Hill*, 161 F.2d 367, 73 USPQ 482 (CCPA 1947). The term "intellectual properties" in claim 21 and 22 is used by the claim to mean "circuit components," while the accepted meaning is "any intangible creations of the human intellect that are protected by law."

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 21-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Krolikowski et al, US Patent 3,760,384.

Art Unit: 2824

Regarding claims 21 and 23, Krolikowski et al discloses expressing a layout pattern of a circuit by using a mask patterns prepared for plural circuit elements in figures 9A – 9C1 and column 11, lines 20-30.

Regarding claims 22 and 24, Krolikowski et al discloses that each mask pattern has a mask for positioning, and the positioning is done by superposing one mask on another in figures 9A – 9C1 and column 11, lines 30-45.

(11) Response to Argument

35 U.S.C 112, second paragraph

In regards to appellant's argument pertaining to 112 2nd paragraph; that the term "intellectual property" (IP) is not indefinite. Appellant states that "intellectual properties" has an accepted meaning in the semiconductor industry. Specifically, intellectual properties are predefined circuits that can be formed on a semiconductor wafer as a component of a larger operational circuit. Appellant cites two websites as appendixes as further evidence. In regards to these websites, the information is taken out of context, the websites do not specifically state the definition as cited above. The websites show that contained within certain organizations exists IP divisions that can design computer architecture or as with the second reference (Design And Reuse) cites strategic IP business plans and a division that does IP design work. Apparently from these websites, there is one or more accepted meaning for intellectual property. According to the "Intellectual Property Owners Association; (appendix A) the definition of intellectual property (as stated in final office action): "is a term used to describe intangible creation of the human intellect that are protected by law". Therefore from the evidence of the websites given, the term intellectual property is indefinite.

Appellants further argue that one of ordinary skill in the art would reasonably ascertain the scope of the claim according to the specification. This scope is indefinite in the specification, specifically the specification states that each of the intellectual properties is a large-scale integrated circuit composed of many circuit elements, such as for example a DRAM. See page 2, line 22 – page 3, line 10. Furthermore; the specification states that examples of IP(s) are microprocessors; memory controllers; cache memory; memory (DRAM); graphics controller. See page 31, lines 7-10, and page 33, lines 20 - 23. Also the specification on page 34, lines 2-5, states that IP(s) can range from a workstation, a PDA, a home game machine, a DVD player, a car navigation system, a digital still-video camera, and integrated OA equipment. Therefore the scope of term intellectual properties is indefinite to one of ordinary skill in the art.

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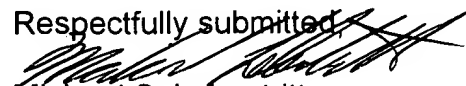
Appellants also argue that the definition of intellectual properties in the specification is not repugnant to the accepted meaning of this term. Repugnance as stated by the appellants, "signifies an inconsistent meaning". As admitted by Appellants the accepted meaning of intellectual property is the "intangible creations of the human intellect that are protected by law". See page 5, line 21 of appeal brief. Therefore the use of the term intellectual properties is repugnant.

PROIR ART REJECTION:

Appellants argue that Krolikowski et al does not teach arranging each mask pattern of the plurality of intellectual properties for a layout pattern as recited in Claim 21. As stated by appellants claim 21 is directed to arranging mask patterns of a plurality of functional circuits that each include a plurality of circuit elements. Krolikowski teaches expressing a layout pattern of a circuit by using mask patterns prepared for plural circuit elements in figures 9a-9c1 and column 1, lines 20-30. Further wherein each mask pattern has a mask for positioning, and the positioning is done by superposing one mark on another in figures 9a-9c1 and column 11, lines 30-45. According to appellant's definition of intellectual properties are circuits that include a plurality of circuit elements to perform a certain function. Krolikowski discloses a method of fabricating an FET memory array. A FET is a Field Effect Transistor is comprised of circuit elements such as gate electrode, source and drain. An array of FET(s) is called a memory cell or chip, the memory cell can be used to store information. Therefore by appellant's definition, a FET memory chip (is a circuit that includes a plurality of circuit elements (FET components) which perform a certain function (storing information).

For the above reasons, it is believed that the rejections should be sustained.


Respectfully submitted,



Michael S. Lebentritt
Primary Examiner
Art Unit 2824

August 28, 2002

cc:

Richard Elms 

Olik Chaudhuri 

Bradley Smith 

APPENDIX A



Intellectual Property Owners Association

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IP Information

PATENTS - Legal Rights for Inventions

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What is a Patent?

Patents give the owner the right to exclude other parties from: making, using, selling, offering to sell, or importing an invention. Exclusive rights in the invention begin when the patent is granted by the U.S. Patent and Trademark Office and expire 20 years after the application for the patent was filed with the Office.

Inventions that can be patented include machines, manufactured products and materials ranging from chemicals to computers, and processes. Every kind of applied technology can be patented, but scientific principles and naturally occurring materials are not patentable.

The owner of a patent may be the inventor, the inventor's employer, or someone who has purchased the rights from the inventor or the employer. Most patents are owned by companies, inventors, or universities. Owners may manufacture themselves, or they may license another party to manufacture and pay the owner a royalty.

Incentives for New Technology

Patent laws, along with copyright laws, were among the earliest laws passed by the First Congress in 1790. Patents and copyrights are authorized in the U.S. Constitution to "promote the progress of science and useful arts." The possibility of patent rights gives incentives to inventors and their employers to create new technology and to invest in commercializing technology. Policy makers have generally agreed that the American tradition of strong patent laws has contributed to making this country the world's technological leader, a position it has held for more than a century.

Dissemination of Technological Information

A patent applicant must give the Patent and Trademark Office a written description of the invention that is adequate to enable a person skilled in the field to make and use the invention. This description is called the "specification."

When the Office grants a patent, the specification is published and disseminated widely to inventors and

industry to spur additional research. The Patent and Trademark Office is one of the world's largest libraries of technological information, with more than 25 million documents.

Obtaining U.S. Patents

In order to be eligible for a patent, an invention must be "new", and it must be sufficiently different so that it is not "obvious" to a person skilled in the field. An invention is not new if it has already been invented by someone else, or if it has been made public more than one year before the patent application is filed. This one year period in U.S. patent law is called the "grace period."

The U.S. Patent and Trademark Office has a staff of scientists and engineers -- patent examiners -- who examine each application to determine whether the invention meets the criteria for obtaining a patent. On the average it takes about two years to obtain a patent after the application is filed. Most applicants hire a patent attorney to file their application and obtain the patent. Patents include "claims" that define the scope of coverage of the patent. The U.S. grants more than 100,000 patents a year.

Obtaining Patents Abroad

A U.S. patent gives exclusive rights only within the United States. Treaties also give Americans the right to apply for patents in other countries, and give nationals of those countries the right to apply here, but patents must be obtained separately in each country, for the most part.

Foreign patent laws differ from U.S. law. Most countries do not afford the one year grace period of U.S. law, which means that a foreign patent cannot be obtained if the invention was made public anywhere in the world even one day before the first patent application is filed. It is very expensive to obtain patents in foreign countries, but efforts are being made to reduce the cost of foreign patenting.

Enforcing Patent Rights

Patent owners can sue in federal court to stop unauthorized parties from practicing the patented invention. Unauthorized parties are "infringers." A successful lawsuit also may give the patent owner monetary damages.

A suit cannot be filed until the patent has been granted by the Patent and Trademark Office. Products that are covered by a patent often are marked with the patent number. Patents are numbered consecutively; more than 5 million have been granted. When a patent application has been filed, products often are marked "PATENT PENDING" or "PATENT APPLIED FOR" to warn competitors that a patent may be granted, but rights do not begin until a patent is granted and rights are not retroactive.

Other Information

Inventors should obtain advice from knowledgeable sources before spending money on marketing or patenting their inventions. Novices should be wary of promoters who claim to have the ability to sell or license inventions to industry on behalf of inventors, especially if the promoter wants to be paid in advance.

In addition to patents for inventions, which are sometimes called utility patents, patents can be obtained for ornamental designs of manufactured articles and for living plant varieties.

Intellectual Property: Products of the Mind

"Intellectual property" is a term used to describe intangible creations of the human intellect that are protected by law. Patents are intellectual property rights.

Other intellectual property rights include copyrights, trademarks, and trade secrets.

COPYRIGHTS protect literary and artistic works, such as books, papers, photographs, art, music, movies, recordings, and software. Copyrighted works, sometimes identified by the symbol ©, may be registered with the U.S. Copyright Office in the Library of Congress.

TRADEMARKS, also called brand names, are words, designs or other symbols that identify and distinguish products and services. An ® denotes a trademark that is registered with the U.S. Patent and Trademark Office.

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